

5 A. The Examiner relies on Guglielmi to teach shrinkage of body lumens by using heat, finding that one having an ordinary level of skill would be led to derive the claimed invention because the teachings were old and well known, as evidenced by Guglielmi. However, a finding by the Examiner that an invention comprises a combination of old elements is insufficient to establish a prima facie case of obviousness. As the Federal Circuit has found, "[m]ost, if not all patentable inventions are novel combinations of known elements; there is only one standard of obviousness for all types of inventions." *Panduit Corp. v. Dennison Mfg. Co. (Panduit II)*, 810 F.2d 1561, 1575 (Fed. Cir. 1983). Furthermore, "[i]t is immaterial to the issue, however, that all of the elements were old in other contexts. What must be found obvious to defeat the patent is the claimed invention." *Kimberley-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 1448 (Fed. Cir. 1984). Here, the Examiner finds the invention obvious based on a bald statement that the elements of the invention are old, in complete disregard of the precedents established by *Panduit II* and *Dennison* and their progeny.

20 B. The Examiner supports his finding of obviousness with a mere conclusion that the claimed invention would have been obvious in view of the references. However, the fact that the references "teach that all aspects of the invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references." MPEP § 2143.01. Here, the Examiner has not pointed to any objective reason to combine the references.

25 C. Additionally, obviousness can only be established "where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP § 2143.01. Here, beyond a mere conclusion that the invention would have been obvious, the Examiner hasn't pointed to any teaching or suggestion to combine the teachings of Slepian and Guglielmi.

30 D. An additional requirement for a finding of obviousness is a reasonable expectation of success. A recognition, either express or implied, in the prior art, or drawn from convincing reasoning based on scientific principles or legal precedent that an advantage or beneficial result would be produced by the combination. MPEP § 2143.02. Here, the Examiner merely concludes that the invention would have been obvious, failing to point to any advantage or beneficial effect resulting from the combination.

E. References cannot be combined when a reference teaches away from the combination. MPEP § 2145. Here, Slepian teaches away from the combination. Slepian describes an apparatus and a product for endoluminal use, the primary object of which is to dilate and maintain the lumen of body structures such as blood vessels and to combat
5 restenosis, or narrowing of the lumen. Thus, Slepian's primary object is the exact opposite of Guglielmi's – shrinking the lumens of dilated structures within the body. Additionally, Guglielmi describes an apparatus that includes an expandable wire cage structure, and coiled wires, that can be detached from the wire used to deploy them, and retained in the
10 body structure to which they have been deployed. However, Slepian extensively discusses the disadvantages posed by use and retentions of wire stents within the body, structures closely resembling the expandable wire cage structure described by Guglielmi. As a solution to the significant disadvantages involved in use of wire structures within the body, Slepian provides biodegradable polymeric sleeves that are deployed to a selected
15 lumen by means of an angioplasty catheter. Accordingly, one having an ordinary level of skill in the art would not be led to combine the teachings of Slepian and Guglielmi to derive the Claimed Invention.

F. The claimed combination cannot change the principle of operation of the primary
20 reference or render the reference inoperable for its intended purpose. MPEP § 2145. In this case, Slepian describes an angioplasty catheter that is uniquely adapted to deploy polymeric sleeves to a selected site. Slepian does provide a heat source, or heating elements; however, such heating means is for the process of treating the polymeric sleeve, rather than the patient's tissue. The placement of the heating elements is specifically suited
25 for their intended use. Modifying Slepian by equipping it to deploy Guglielmi's expandable wire basket would both render Slepian's apparatus inoperable for its intended purpose and change its principle of operation.

In view of the above, the rejection of Claim 1 and all Claims depending therefrom under
30 USC § 103(a) is deemed to be Improper.

2. Claims 1, 2, 8, 14 20 and 23 stand rejected under 35 USC § 103(a) as being unpatentable over United States Patent No. 5,938,660 ("Swartz") in view of Guglielmi. Applicant respectfully disagrees. The current finding suffers from many of the defects
35 pointed out above, specifically those of paragraphs 1A – D.

3. Claim 3 stands rejected under 35 USC § 103(a) as being unpatentable over Swartz in view of Guglielmi and further in view of WO 85/02779 ("Goffinet"). Applicant respectfully disagrees. Because the Examiner has failed to establish a prima facie case of obviousness based on the combination of Swartz and Guglielmi, the current rejection is also
5 deemed improper.

4. Claim 24 stands rejected as being unpatentable over Slepian in view of Guglielmi and further in view of United States Patent No. 5,423,744 ("Gencheff"). Because the Examiner has failed to establish a prima facie case of obviousness based on the
10 combination of Slepian and Guglielmi, the current rejection is also deemed improper.

5. Claim 33 stands rejected under 35 USC § 103(a) as being unpatentable over Swartz in view of Guglielmi and further in view of United States Patent No. 5,971,983 ("Lesh"). Because the Examiner has failed to establish a prima facie case of obviousness
15 based on the combination of Swartz and Guglielmi, the current rejection is also deemed improper.

CONCLUSION

20 In view of the foregoing, the Application is deemed to be in allowable condition. Therefore, Applicant earnestly requests the Examiner to withdraw all rejections, allowing the Application to pass to issue as a United States Patent. Should the Examiner have any questions regarding the Application, he is urged to contact Applicant's attorney at the
25 telephone number given below.

Respectfully submitted,



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